

REMARKS

Introduction

Claims 1-19 were originally pending in this application. Claims 1, 2, 4, 6, 8, 12 and 16 have been amended herein. Claims 18 - 19 have been cancelled. Thus, claims 1 - 17 remain pending in this application. No new matter has been added.

Claim Rejections

35 U.S.C. § 102(b)

Claims 1, 10, 12 - 14, 16, and 17 were rejected under 35 U.S.C. § 102(b) as being anticipated by Schenkel. Claims 18 and 19 were rejected under 35 U.S.C. § 102(b) as being anticipated by Wang et al., and dependant claims 11 and 15 were rejected under 35 U.S.C. § 103 as being unpatentable over Schenkel. With the Examiner's comments in mind, claims 1, 2, 4, 6, 8, and 12 have been amended to make clear that the chevron/cross-hatching patterns formed in the coating are disposed at predetermined angles relative to the longitudinal axis of the piston. In this way, applicants further distinguish the present invention from the related art by adding descriptive language to clarify the shape of the patterns formed by the coating on the skirt of the piston. Similarly, independent claim 16 has been amended to state that the outer circumference of the body of the piston is smooth. In this way, claim 16 has been clarified to state that the coating forms a series of lubricating discs disposed in uniform spaced relationship on the relatively smooth circumference of the body of the piston. Finally, claims 18 - 19 have been cancelled.

Applicants respectfully submit that independent claims 1, 12, and 16 each recite structure that is not disclosed or suggested by the prior art and are patentably distinguishable from the subject matter of the references of record in this case. Dependent claims 2 - 11, 13 - 15 and 17

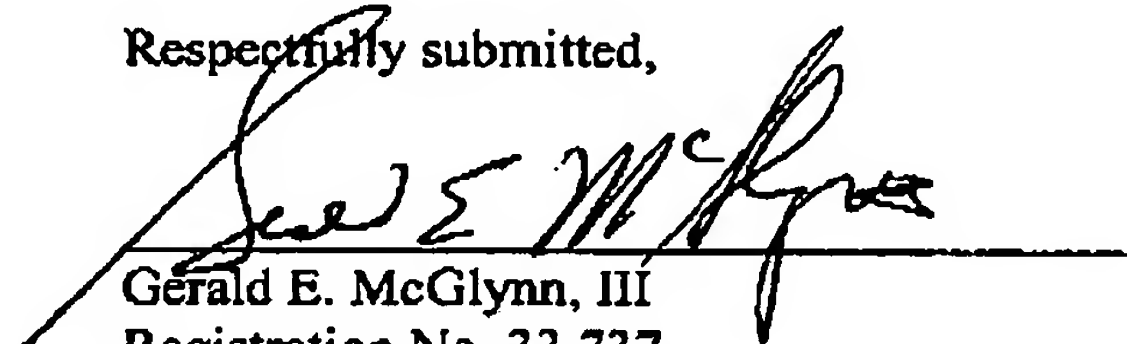
are each ultimately dependent upon one of these independent claims and add further perfecting limitations. As such, the prior art references do not suggest the subject invention. However, even if they did, they could only be applied through hindsight after restructuring the disclosure of the prior art in view of applicants' invention. The combination of the prior art in this way to derive applicants' invention would, in and of itself, be an invention.

Conclusion

Applicants respectfully submit that the amendments made herein comply with the requirements of form expressly set forth in the previous office action and otherwise present this application in better form for consideration on appeal. Accordingly, applicants respectfully request that this amendment be admitted pursuant to 37 CFR 1.116 and that the rejections previously advanced be withdrawn.

Finally, applicants respectfully maintain that the claims, as amended, clearly distinguish over the prior art and are therefore allowable. Accordingly, applicants respectfully solicit the allowance of claims 1 - 17 pending in this case.

Respectfully submitted,



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